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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,270	05/02/2001	Palpu Pushpangadan	056859-0126	6119
22428	7590	03/30/2005	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			KIM, JENNIFER M	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/846,270

Applicant(s)

PUSHPANGADAN ET AL.

Examiner

Jennifer Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 71,72,76-79,84-91 and 120-148 is/are pending in the application.
- 4a) Of the above claim(s) 120-148 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 71,72,76-79 and 84-91 is/are rejected.
- 7) ☒ Claim(s) 84-89 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 9, 2004 has been entered.

Applicants' arguments with respect to claims 71, 72, 76-79, 84-91 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

Claims 84-89 are objected to because of the following informalities: Claims 84-89 depend from the cancelled claim 83. Appropriate correction is required.

For compact prosecution, claims 84-89 are examined, as claims 84 and 87 are depend on claim 71.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 71, 72, 76-79, 84-91 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With regard to claim 71, a cosmetically acceptable "lipstick, eye shadow, glitter or rouge base material" lack literal support in the specification as filed. Instant specification has support for the "cosmetically acceptable base material" not "lipstick, eye shadow, glitter or rouge base material". The remaining claims are rejected to the extent that they depend on claim 71.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 71, 72, 76-79, 84-91 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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With regard to claim 71, it is not clear what are the "lipstick, eye shadow, glitter or rouge base material" since there is no example or compounds disclosed in the specification.

With regard to claim 72 is indefinite since it is not clear what are the "side effects" what are not caused by the claimed composition. The claim is unclear since instant specification does not disclose any examples of the side effects that can be eliminated by the composition.

With regard to claim 91, it recites the limitation "essential oils/aroma isolates" in line 2. There is insufficient antecedent basis for this limitation in the claim.

The remaining claims are indefinite to the extent that they depend on claim 71.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 71, 72, 77, 79, 84-88 and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by Schultz (2002/0082279) of record.

Schultz teaches a composition for the treatment of dermatologic diseases comprising an active agent, essential oils, and a carrier (cream, ointment, lotion, solution, gel, etc.). The composition is taught as treating acne, dermatitis, wrinkles and other disorders. Citronella (synonym for cymbopogon nardus), basil (synonym for ocimum basilicum), Eucalyptus, jasmine and **Tagetes** are taught as essential oils with direct skin effects for use in his composition. The essential oils are further taught as moisturizing the skin. See [0003]-[0019]. Schultz teaches the essential oils can be from 0.001 to 20% by weight and preferably about 0.01 to about 3% by weight of the total weight of the topical composition.

Applicants' recitation in claims of an intended use (i.e. lipstick, eye shadow, glitter or rouge) does not represent a patentable limitation since such fails to impart any physical limitation to the same composition taught by prior art. Further, it is well recognized in the patent law that for composition claim is that portion stated after the term "comprising" therefore applicant's composition claims for a lipstick, eye shadow, glitter or rouge read upon the same composition comprising same active agents by the prior art. Moreover, Applicants' recitation of the composition being non-toxic and does not cause side effects set forth in claim 72, the solubility of herbal colorants set forth in claim 77, the shades of the herbal colorants set forth in claim 84, and the intensity variants of the herbal colorants set forth in claims 85-88 would be an inherent property of the same composition comprising same herbal colorants taught by the prior art.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 71, 76, 78, 89 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz (2002/0082279) of record.

Schultz teaches a composition for the treatment of dermatologic diseases comprising an active agent, essential oils, and a carrier (cream, ointment, lotion, solution, gel, etc.). The composition is taught as treating acne, dermatitis, wrinkles and other disorders. Citronella (synonym for cymbopogon nardus), basil (synonym for ocimum basilicum), Eucalyptus, jasmine and **Tagetes** are taught as essential oils with direct skin effects for use in his composition. The essential oils are further taught as moisturizing the skin. See [0003]-[0019]. Schultz teaches the essential oils can be from 0.001 to 20% by weight and preferably about 0.01 to about 3% by weight of the total weight of the topical composition.

Schultz does not teach the source of extract set forth in claim 76, pH of colorants set forth in claim 78, amounts of base set forth in claim 89.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the amounts of the active ingredients, extracting herbal colorants from roots, stem or leaves of the plants and optimize the pH in the combined references because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involved only routine skill in the art. In re Aller, 105 USPQ 233.

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For these reasons the claimed subject matter is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. The claims are therefore properly rejected under 35 U.S.C. 103.

None of the claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kim whose telephone number is 571-272-0628. The examiner can normally be reached on Monday through Friday 6:30 am to 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sreenivasan Padmanabhan  
Supervisory Examiner  
Art Unit 1617

Jmk  
March 15, 2005